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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,210	01/02/2004	Keneth K. Cyr	CRNI.111423	6655

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EXAMINER	
DUNHAM, JASON B	
ART UNIT	PAPER NUMBER
3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/750,210	CYR ET AL.	
	Examiner	Art Unit	
	JASON B. DUNHAM	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/30/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-38 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for a claim covering every conceivable means for achieving the recited purpose of generating a set of clinically related supplies. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. See, in *Fiers v. Revel,* (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use "means-plus-function" language.

Instant claim 27 is drawn to any "set of clinically related supplies generated for delivery", regardless of construct, that performs the function recited. This parallels the fact situation in *Fiers* wherein "a DNA" and a result was recited. The CAFC stated in *Fiers* at 1606 "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived". See also *Ex parte Maizel,* (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung,* (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous to single *means* claims even though "means" was not literally used. Thus independent claim 27 (and its related

dependents) are properly rejected under 35 USC 112, 1st paragraph as the claim yields a "set of clinically related supplies generated for delivery " that achieves a result without defining what will do so.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27 -38 are rejected under 35 U.S.C. 112, 2nd paragraph.

It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved-IPXL Holdings LLC v. Amazon.com Inc., 77 USPQ2d 1140 (CA FC 2005); Ex parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990)

A single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention-Ex Parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-38 rejected are under 35 U.S.C. 102(b) as being anticipated by DeBusk (US 5,682,728).

Referring to claim 1. Debusk discloses a system for automatically fulfilling orders for clinically related supplies, comprising:

- An interface to a supply chain engine, the supply chain engine automatically generating at least one order for clinically related supplies based upon supply consumption data derived from documentation of at least one clinical event reported from at least one clinically related site, the supply consumption data including items used or consumed during the at least one clinical event (Debusk: column 5, lines 6-21 and column 6, lines 47-59). The examiner submits that DeBusk discloses generating orders based upon specific patient's needs in a clinical event such as surgery.
- A fulfillment engine, communicating with the interface to the supply chain engine, the fulfillment engine triggering delivery of clinically related supplies based at least upon the at least one order for clinically related supplies (DeBusk: column 4, lines 51-65).

Referring to claim 2. Debusk further discloses a system wherein the clinically related site comprises a hospital facility (DeBusk: column 1, lines 13-39).

Referring to claim 3. Debusk further discloses a system wherein the supply consumption data includes clinically available quantities of surgical devices (DeBusk: column 1, lines 36-48, column 2, lines 29-40, and column 6, lines 47 - 59).

Referring to claim 4. Debusk further discloses a system wherein the supply chain engine generates the at least one clinical supply order based upon at least one clinical quantity threshold (DeBusk: column 3, lines 25 – 50).

Referring to claim 5. Debusk further discloses a system wherein the at least one order for clinically related supplies comprises a purchase order (DeBusk: column 2, line 41 – column 3, line 24).

Referring to claims 6-7. Debusk further discloses a system wherein the supply consumption data includes supply codes captured in the at least one clinically related site and are manually entered codes (DeBusk: column 3, lines 25-50).

Referring to claim 8. Debusk further discloses a system wherein the at least one order comprises a plurality of orders, and the fulfillment engine aggregates the order for clinically related supplies for delivery (DeBusk: figure 3).

Referring to claim 9. Debusk further discloses a system wherein the orders for clinically related supplies are aggregated for a plurality of clinical departments (DeBusk: column 3, lines 25-50).

Referring to claim 10. Debusk further discloses a system wherein the at least one order for clinically related supplies is associated with an individual patient supply record (DeBusk: column 6, lines 47-59).

Referring to claim 11-12. Debusk further discloses a system wherein the fulfillment engine triggers delivery of the at least one order for clinically related supplies based upon the at least one order for clinically related supplies and upon a set of rules (DeBusk: column 4, lines 51-65), the set of rules comprising a set of selectors based upon patient condition information (DeBusk: column 4, lines 30-65).

Referring to claims 13-14. Debusk further discloses a system wherein the fulfillment engine is local or remote to the at least one clinically related site (DeBusk: column 5, lines 6-21).

Referring to claims 15 - 26. Method claims 15-26 are rejected under the same rationale set forth above in the rejection of systems claims 1-14 containing similar limitations.

Referring to claims 27-38. See the 35 USC 112, 1st and 2nd paragraph rejections above indicating that no weight has been given to the method steps within the single means claims as they don't move to structurally define the product. However, for purposes of examination, even if weight was given in defining the product as purported by applicant, the limitations are rejected under the same rationale set forth above in the rejection of claims 1-14.

Response to Arguments

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Applicant's arguments filed June 30, 2008 regarding the 35 USC 102(b) rejection in view of DeBusk have been fully considered but they are not persuasive. Applicant argues that Debusk does not disclose supply consumption data derived from documentation of at least one clinical event including items used and/or consumed during a clinical event. The examiner disagrees. Column 5, lines 50-67 of DeBusk disclose a hospital, through its historical usage records for its medical supplies for a given care event (emphasis added), can readily order from a manufacturer, those medical supplies required for a given care event. Therefore, DeBusk does disclose data derived from a clinical event (i.e. historical usage records of supplies for previous care events) for order future supplies for a similar care event.

Applicant further argues that DeBusk does not disclose generating an order based on a clinical quantity threshold as recited in claim 4. The examiner disagrees. DeBusk discloses stocking medical supplies on the basis of historical information as to the number of given medical procedures (care events) that are to be expected within a given time frame based on statistically calculable demands. The demands are calculated to reduce supply inventory while allowing the institution to maintain available supply when needed (column 3, lines 25-50). The examiner submits that the calculable demands used to maintain supply by ordering by procedure are equivalent to a quantity threshold.

Independent claims 15 and 27 and the respective dependent claims of claims 1, 15, and 27 are rejected under the same rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art Unit 3625

JBD
Patent Examiner
7/10/08